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Docket No. 188/167

AMENDED NOTICE OF APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF APPEALS

In re Application of: ANTHONY MAGLICA

Serial No.: 07/411,576

For: MINIATURE FLASHLIGHT

Filed: September 22, 1989

Group Art Unit: ~~346~~ 291

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

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GROUP 290

4/14

93-0363

Sir:

Applicant hereby appeals to the Board of Appeals from the decision dated March 11, 1992 of the Primary Examiner.

The item checked below are appropriate:

1. ☒ An extension of time to respond to the final rejection was granted on March 11, 1992 for 3 month(s). Fee enclosed:
☒ small entity \$405.00 ☐ other than small entity \$810.00
2. ☐ A timely response to the final rejection has been filed, as provided in 841 O.G. 1411.
3. ☒ Appeal Brief Fee enclosed:
☒ small entity \$130.00 ☐ other than small entity \$260.00
☐ Fee not required (Fee paid in prior appeal)
4. ☒ AN ORAL HEARING IS REQUESTED.
☒ small entity \$110.00 ☐ other than small entity \$210.00
- ☒ The Commissioner is hereby authorized to charge payment of the fees associated with this communication, or credit any overpayment, to Deposit Account 12-2475. A duplicate copy of this sheet is enclosed.
- ☒ I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date of signature hereof with sufficient postage as first class mail in an envelope addressed to the: Commission of Patents and Trademarks; Washington, D.C. 20231.

Signature (Rule 191(b))

Robert C. Weiss
Robert C. Weiss, Reg. No. 24939

May 18, 1992
Date of Signature
Post Office Address to which
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GROUP 290

#20 Appeal
Brief
6-25-92
188/167 TM
Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:

ANTHONY MAGLICA

Serial No. 07/411,576

Filed: September 22, 1989

For: MINATURE FLASHLIGHT

) Group Art Unit: 346

) Examiner: M. Tung

930363

) Los Angeles, CA 90017

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington.

D.C. 20231 on 5/18/92

(Date of Deposit)

Robert C. Weiss

Registered Representative

[Signature]

Signature

5/18/92

Date of Signature

APPEAL BRIEF

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

May 18, 1992

Dear Sir:

This brief is an appeal from the final rejection by the Examiner dated July 18, 1991. The application and claim is properly formed and the issues distilled and ripe for appeal.

STATUS OF CLAIMS

The design claim on appeal was finally rejected by the Examiner under 35 U.S.C. §103 as being unpatentable over Maglica, U.S. Patent No. 4,658,336 in view of Huang, U.S. Patent No. 4,750,095. These patents would not qualify as prior art except

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the Examiner has held that the present application is not entitled to the benefit of continuity extending back to the original parent application, Serial No. 648,032 filed on September 6, 1984. The claim was also rejected under 35 U.S.C. § 112, first paragraph. The Examiner contended that the new formal drawings introduce new matter between the original and new drawings.

STATUS OF AMENDMENTS AFTER FINAL REJECTION

The design claim on appeal reflects an Amendment After Final Rejection which was filed December 23, 1991, and which was entered by the Supplementary Advisory Action dated March 11, 1992 and the present formal drawings which were filed on January 7, 1992 and which were entered by the Advisory Action dated February 6, 1992. The present formal drawings overcame certain aspects of the final rejection of the claim under 35 U.S.C. §112.

SUMMARY OF THE INVENTION

The invention relates to the candle mode design of a flashlight. The pending application is a division of a utility patent application, Serial No. 456,361, filed on May 23, 1989, which issued as U.S. Patent No. 4,942,505 and which is a continuation of several parent utility applications, including the original utility parent application, Serial No. 648,032 filed on September 6, 1984, which issued as U.S. Patent No. 4,577,263. This pending application is also related to U.S. design application, Serial No. 410,965, also filed on September 22, 1989 and also on Appeal.

The product which is the subject of the invention has enjoyed remarkable commercial success. In litigation involving certain of the parent patents^{1/}, Kassnar Imports, Inc. v. Mag Instrument, Inc. Civil Action No. CV-86-0802; Judge Ferdinand F. Fernandez, then a United States District Court Judge who has since been elevated to the Ninth Circuit Court of Appeals, stated as follows:

"The Mini-Maglite was the invention of Anthony Maglica (hereinafter 'Mr. Maglica'). It was such an elegant piece of engineering, and was manufactured to such high quality standards that it took the industry by storm. A once sleepy backwater in the economy became a segment with an extraordinary growth rate. The success went against all of the conventional wisdom of the industry and actually revolutionized it. This product has been called a textbook example for those who are interested in analyzing the business sector."

This flashlight was given acclaim by persons throughout the industry, including the competitors of the applicant, Mag Instrument, Inc. ("Mag"). Indeed, one such competitor testified that this flashlight was " . . . the greatest thing to happen in the flashlight industry in my 29 years that I was manufacturing flashlights." (Information Disclosure Statement, pp. 38-39). Additional evidence regarding the attributes of this invention is

^{1/} A complete description of the litigation relating to the parent patents is set forth in the Information Disclosure Statement Under 37 CFR §1.56 dated May 13, 1991.

set forth in the Statement Re Secondary Considerations dated May 13, 1991.

The tremendous success of this invention has brought about a multitude of copiers. The activities of several of these copiers have been curbed through the enforcement by Mag of the parent utility patents. However, certain imitators have sought to capitalize on the success of Mag's Mini-Maglite flashlight by foregoing the patented utility features of the invention and copying merely the aesthetic features of the invention. Such copying has caused widespread deception and confusion of purchasers.

Unfortunately, and through no fault of Mag, a design patent application was not filed at the time the original parent utility application was filed. Despite the instructions of the inventor, Anthony Maglica, to his then patent attorneys to prepare and file a design patent application, the patent attorneys negligently failed to file such a design application.^{2/} The present design application was filed following the decision by the Federal Circuit in Racing Strollers, Inc. v. TRI Industries, 11 USPQ 2d 1300 (CAFC 1989).

ISSUES PRESENTED FOR REVIEW

The Examiner rejected the claimed invention under 35 U.S.C. §103 over one of applicant's parent patents, Maglica, U.S. Patent No. 4,658,336, in view of Huang, U.S. Patent No. 4,750,095. Both of these patents were filed subsequent to the filing of the original parent utility application, Serial No. 648,032, which

^{2/} The facts regarding this matter are set forth in the August 9, 1991 declaration of Anthony Maglica which was attached to his declaration which was filed December 23, 1991.

was filed on September 6, 1984. The present application claims continuity based on this original parent utility application which, if granted, would overcome the Examiner's rejection under 35 U.S.C. §103. The Examiner denied the claimed design the benefit of continuity from the original parent utility application, Serial No. 648,032, based on the Examiner's perception of a difference between the profile of the head of the flashlight shown in the present set of formal drawings and the profile of the head shown in the original drawings filed in connection with the parent application, Serial No. 648,032. Appellant contends that the profile of the flashlight head shown in all views of the present set of formal drawings is the same as the profile of the flashlight head shown in Figures 2 and 3 of the original drawings.

There are two issues presented for review. The first issue involves the question of whether the profile of the head of the flashlight shown in the present formal drawings is the same as the profile of the head of the flashlight shown in Figures 2, 3 and 8 of the original drawings. This issue, however, gives rise to a sub-issue regarding whether the subjective opinion of the Examiner that the profiles are different can overcome the sworn testimony of applicant's engineer and the accompanying technical evidence that the profiles are the same. This first issue and the sub-issue are the same as those presently before the Board in connection with the pending Appeal of the companion, U.S. Design Patent Application, Serial No. 410,965, scheduled for hearing on May 19, 1992. The second issue is whether the present formal drawings are reasonably supported by the original drawings.

ARGUMENT

The rejections of the present design claim should be reversed. The ground for rejection under 35 U.S.C. §103 would be overcome if the present application is given the benefit of continuity from the original parent utility application, Serial No. 648,032. The 35 U.S.C. §103 rejection is based on two patents filed after the original parent utility application. The present application should be given the benefit of continuity from the original parent utility application because there is adequate support for the present claimed design in the original drawings. The rejection under 35 U.S.C. § 112, first paragraph should be reversed because any difference between the original drawings and the present formal drawings are insignificant and because the design of the flashlight shown in the present formal drawings is adequately supported by the original drawings.

1. The Rejection Under 35 U.S.C. § 103

The entire basis of the Examiner's rejection and refusal to grant the present design application the benefit of continuity of the original parent utility application, Serial No. 648,032, is based on the Examiner's subjective perception that the shape of the head shown in the present formal drawings differs from the shape of the head shown in the original 648,032 drawings.

Sworn testimony and technical data have been submitted by the Appellant to demonstrate that the shape or profile of the head of the flashlight in the present formal drawings is the same as the shape or profile of the head of the flashlight shown in Figures 2 and 3 of the original drawings. (See the declaration of Fred R. McAlister filed December 23, 1991 and attached other

declarations of Mr. McAlister). The Examiner has not demonstrated in any objective fashion that the shape or profile of the head of the flashlight in the present formal drawings is different from the shape or profile of the head of the flashlight in Figures 2 and 3 of the original drawings.

The difficulty with this case is that without directly saying it, the Examiner is attempting to restrict Appellant's invention to a flashlight with a head which conforms to that shown in Figure 1 of the original drawings. It has been the Examiner's position during the prosecution of the present application that the head of the flashlight must have an angled profile in order to be entitled to the benefit of continuity from the original parent utility application, Serial No. 648,032. The only figure in the original drawings which supports this position is Figure 1. Figures 2 and 3 do not reflect an angled profile.

As set forth in the Supplemental Response and accompanying declarations of Fred R. McAlister and Anthony Maglica filed December 23, 1991, Figure 1 of the original drawings involves an error by the draftsman. This error created an inconsistency between Figure 1 and Figures 2 and 3 of the original drawings.

The law is clear that a design application based upon an earlier parent utility application is not restricted to any particular illustration in the earlier application, but instead may rely on any of the illustrations. In Racing Strollers, Inc. v. TRI Industries, 11 USPQ 2d 1300 at 1301, the Federal Circuit stated:

"As a practical matter, meeting the remaining requirements of §112 [those other than best mode] is, in the case of an

ornamental design, simply a question of whether the earlier application contains illustrations, whatever form they may take, depicting the ornamental design illustrated in the later application and claimed therein by the prescribed formal claim . . ."

(Emphasis added).

See also Ex Parte Asano, 201 USPQ 315, 318 (Bd. App. 1978) where the Board stated:

"The errors, as we see them, are minor drafting errors or Figure inconsistencies, and it is not new matter to correct minor drafting errors or to make one figure of the drawing consistent with other figures. The test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed, but whether there is support anywhere in the drawings for the necessary or desirable figure corrections." (Emphasis added).

Thus, to the extent that any figure inconsistencies or drawing errors exist in the drawings of the earlier application, such inconsistencies and errors are not a sufficient basis for holding that the design application is not supported by the earlier utility application. Ex Parte Asano, 201 USPQ 315, 317 (Bd. App. 1978). See also Hadco Products, Inc. v. Lighting Corp. of America, Inc., 165 USPQ 496 (DC E.Pa., 1970), reversed on other grounds, 174 USPQ 358, cert. den. 175 USPQ 678, relied on by the Board in Ex Parte Asano, supra.

In an attempt to demonstrate to the Examiner that the profile of the head of the flashlight in the present formal drawings is the same as the profile of the head of the flashlight shown in Figures 2 and 3 of the original drawings, Appellant, as indicated above, has filed various declarations of Fred R. McAlister. The declarations of Mag's engineer, Mr. McAlister, set forth the detailed steps of a method used to duplicate for purposes of the present formal drawings the profile of the head of the flashlight shown in Figure 2 of the original drawings. In paragraph 3 of his December 16, 1991 declaration, Mr. McAlister states that the head profile of the flashlight of the present formal drawings has the same reproduced head profile of Figure 2 of the original drawings.^{3/} The May 28, 1991 declaration of Mr. McAlister states how a photocopy of the flashlight of the present formal drawings was enlarged so that the head of the flashlight shown in those drawings would be the same size as the head of the flashlight in Figure 2 of the original drawings. This enlarged photocopy allows for a direct comparison of the two head profiles. Transparencies of the enlarged copy of the head of the flashlight in the present formal drawings and of a copy of the head of the flashlight in Figure 2 of the original drawings were also submitted for comparison purposes.

^{3/} The shape of the head of the flashlight shown in the present formal drawings was generated by the method described in Mr. McAlister's May 28, 1991 declaration which is attached to his December 16, 1991 declaration. The shape of the head in the present formal drawings is the same shape as the flashlight head shown in the formal drawings of U.S. Design Patent Application, Serial No. 410,965. (December 16, 1991 Declaration of McAlister, Paragraph 3). The exhibits and declarations submitted in connection with U.S. Design Patent Application, Serial No. 410,965, and relating to the issue regarding the shape of the flashlight head are fully applicable to the issue regarding the shape of the flashlight head in this case.

We also request that the Board make a comparison using the series of transparencies and copies which comprise Exhibit I and Exhibit II of the Appeal Brief filed in connection with the companion design application, Serial No. 410,965. Exhibit I comprises two transparencies, one in red and one in black, and two photocopies, one in red and one in black, of the head of the flashlight shown in Figure 2 of the original drawings. Exhibit II comprises two transparencies, one in red and one in black, and two photocopies, one in red and one in black, of an enlarged flashlight head having the same shape or profile as the head of the flashlight shown in the present formal drawings. These various transparencies and photocopies can be overlapped to show that the profile of the head of the flashlight in Figure 2 of the original drawings and the profile of the head of the flashlight shown in the present formal drawings are the same. Another significant comparison is Exhibit XV of Mr. McAlister's declaration dated November 21, 1991, which is attached to his declaration filed on December 23, 1991.

Despite this objective evidence, the Examiner has refused to grant the present application the benefit of continuity from the original parent utility application, Serial No. 648,032, on the ground that the profile of the head of the flashlight in the present formal drawings is a different shape than the profile of the head of the flashlight in the original drawings. In contrast to the evidence submitted by the Appellant, including Mr. McAlister's sworn testimony, and the objective comparison to show that the head profiles are the same, the Examiner relies entirely upon a subjective perception that the profile shapes are different. We submit that such an approach is improper.

Even if there were some slight difference between the shape of the profile of the head of the flashlight of the present formal drawings and the shape of the profile of the head of the flashlight shown in the originals drawings, such a slight difference should not preclude the benefit of continuity. As stated by the Board in Ex Parte Asano, supra., at page 317, ". . . neither the statute (35 U.S.C. §112) nor the regulation (37 CFR 1.152) requires blueprint type drawings of an exact scale."

The Examiner has not shown how the profile of the head of the flashlight of the present formal drawings is different from the profile of the head of the flashlight shown in Figures 2 or 3 of the original drawings. By using the transparencies and comparing the profile of the flashlight of the present formal drawings with the profile of the head of the flashlight shown in Figure 2 of the original drawings, it can be seen that even under conditions of blueprint exactness the profiles are the same. Because the flashlight shown in the present formal drawings is adequately supported by the original 648,032 drawings, continuity extends back to September 6, 1984, the date when the original parent utility application, Serial No. 648,032, was filed. Thus, the present invention precedes both the prior art patents relied on by the Examiner, Maglica, U.S. Patent No. 4,658,336 and Huang, U.S. Patent No. 4,750,095 and this eliminates the Examiner's rejection under 35 U.S.C. § 103.

2. The Rejection Under 35 U.S.C. § 112, First Paragraph

The Examiner has also rejected the claim under 35 U.S.C. § 112, first paragraph, for two reasons. The Examiner in the Official Action dated July 18, 1991, stated as follows:

"c) The candle end of the flashlight shows a partially uncovered light in the new drawing, but the original shows a completely covered light. Note C, Fig. 1 on the attached photoprints of the new and original drawings.

d) The new drawing shows a proportionally wider and taller threaded end and a smaller flat top disc. Note D, Figs. 1-3."

While it was not agreed that the above rejection was a proper rejection under 35 U.S.C. § 112, new formal drawings were submitted on January 7, 1992, which had been modified to overcome these above problems. However, the Examiner contends that the alleged problems set forth above have not been overcome. (Advisory Action dated February 6, 1992).

Aside from merely circling the areas on the drawings where the problem is perceived to exist and designating them with the letters "C" and "D," the Examiner never made clear what was the exact nature of the perceived problems. These perceived problems were thought to have been overcome because in the new formal drawings the light was changed at "C," the proportional width and height of the threaded end were modified and the disc was changed. These changes and modifications were intended to make the design of the flashlight shown in the present formal drawings

match as closely as possible what was shown in the original 648,032 drawings. Any differences which may exist are so slight that they are inconsequential and not new matter.

As set forth in MPEP § 1505:

"In general terms, if the additional or amended illustration is reasonably supported by the original disclosure under 35 USC 112, first and second paragraphs, it will not be refused entry." (Emphasis added).

Again, the case of Ex Parte Asano, 201 USPQ 315 (Bd.App. 1978) is particularly instructive. In Asano case, the examiner rejected the design claim citing nineteen areas of drawing problems. In reversing the decision of the examiner, the Board stated in Asano, 201 USPQ at 317:

"While we agree with the general premise, as stated by the examiner that, in design applications, the drawing or drawings constitute substantially the entire disclosure of the application and must therefore be well executed both in clarity of showing and completeness to provide an enabling disclosure and definiteness of the claimed subject matter (see 1503.02 MPEP), neither the statute (35 USC 112) nor the regulation (37 CFR 1.152) requires blueprint type drawings of an exact scale.

. . .

Mechanical drawing errors and inconsistencies between the figures of the drawings, which do

not preclude the overall understanding of the drawing as a whole are in insufficient basis for holding the design both indefinite and insufficiently disclosed under 35 USC 112. . . . we consider the numerous mechanical drawings errors and figure inconsistencies noted by the examiner to be insignificant, and that they would present no problems as far as making the disclosed design to one of ordinary skill in the art." (Emphasis added).

The Board further stated in Ex Parte Asano, supra, 201 USPQ at 318:

"The errors, as we see them, are minor drafting errors or Figure inconsistencies, and it is not new matter to correct minor drafting errors or to make one figure of the drawing consistent with other figures. The test for new matter is not whether the desired correction was ever specifically illustrated in a particular figure as filed, but whether there is support anywhere in the drawings for the necessary or desirable figure corrections.

See also Ex Parte Kosugi, 144 USPQ 136 (Bd. App. 1964) cited by the Board in Ex Parte Asano, supra.

For the reasons set forth above, we submit that the Examiner's rejection of the claim under 35 U.S.C. § 112, first paragraph has been overcome.

ORAL HEARING

It appears from our records that the Notice of Appeal when originally submitted on December 23, 1991 inadvertently failed to request an oral hearing. Because an oral hearing is desired, an amended Notice of Appeal is being submitted herewith along with the appropriate fee.

CONCLUSION

The rejection by the Examiner under 35 U.S.C. § 103 based on a refusal to extend to the present design application the benefit of continuity from the original parent utility application and the rejection by the Examiner under 35 U.S.C. § 112, first paragraph, are legally and factually flawed. Therefore, Appellant respectfully requests that the rejections be reversed and that the present application be allowed.

Dated: May 18, 1992

Respectfully submitted,

LYON & LYON

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